



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Thiele, Jr.

Serial No.: 10/827,564

Group Art Unit: 3652

Filed: April 19, 2004

Examiner: D. Kramer

For: SHOVELS AND OTHER IMPLEMENTS WITH SCALLOPED LEADING EDGES

RESPONSE TO NON-FINAL OFFICE ACTION

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed September 27, 2007, Appellant has chosen to exercise option (2) as outlined on page 2 of the Office Action, and hereby submits its new Appeal Brief. Appeal fees have increased since Appellant's previous Appeal; accordingly, authorization is given to charge Deposit Account 07-1180 in the amount of the \$10.00.

Respectfully submitted,

By: _____

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APPELLANT'S APPEAL BRIEF UNDER 37 CFR §41.37

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real party and interest in this case is Richard Thiele, Jr., Applicant and Appellant.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

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III. Status of Claims

The present application was filed with 12 claims. Claims 1-12 are pending, rejected and under appeal. Claim 1 is the sole independent claim.

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**IV. Status of Amendments Filed Subsequent
Final Rejection**

Applicant attempted to file an after-final amendment on July 30, 2007 for the sole purpose of correcting problems with antecedent basis under 35 USC §112, second paragraph. Rather than enter the amendment to clean up the claims, the Examiner refused to do so, such that the §112, second paragraph rejections remain.

V. Summary of Claimed Subject Matter

Independent claim 1 is directed to an improved blade for a shovel having an elongated handle (102). The blade comprising a scoop portion (104, 204) having a width (W), a length (L), and a leading edge furthest away from the handle. A plurality of concave scallops (110, 602, Figures 1-6) are present on the leading edge. Each scallop defines a segment of a single circle, and the segments intersect at distinct forward points in a straight line generally perpendicular to the handle. (Specification, page 2 line 19 to page 4, line 9).

VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

- A. The rejection of claims 2-12 under 35 USC §112, second paragraph.
- B. The rejection of claim 1, 6-7 and 9-12 under 35 USC 103(a) over Hicks, U.S. Patent No. 342, 961, in view of either U.S. Design Patent No. D308,004 to Dawley et al. or U.S. Patent No. 2,787,058 to Vogel, wherein claims 6-7 and 9-12 stand/fall with claim 1;
- C. The rejection of claims 2-5 under 35 USC 103(a) over Hicks, U.S. Patent No. 342, 961, in view of either U.S. Design Patent No. D308,004 to Dawley et al. or U.S. Patent No. 2,787,058 to Vogel;
- D. The rejection of claim 8 under U.S.C. §103(a) over Hicks/ Dawley et al. or Hicks/ Vogel and further in view of Johnson, U.S. Patent No. 2,782,615.

VII. Argument

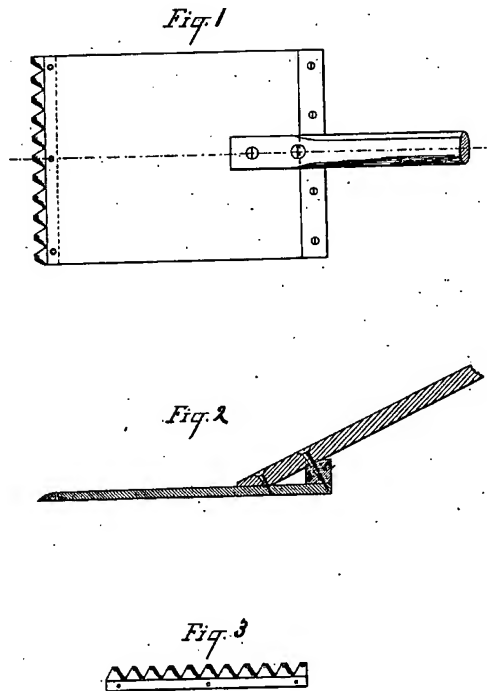
- A. The rejection of claims 2-12 under 35 USC §112, second paragraph.

Applicant attempted to file an after-final amendment on July 30, 2007 to overcome this rejection. The amendment was not entered but the paperwork associate therewith is of record. If this is ever allowed, Appellant will amend the claims as set forth in the non-entered amendment.

- B. The rejection of claim 1, 6-7 and 9-12 under 35 USC 103(a) over Hicks, U.S. Patent No. 342, 961, in view of either U.S. Design Patent No. D308,004 to Dawley et al. or U.S. Patent No. 2,787,058 to Vogel, wherein claims 6-7 and 9-12 stand/fall with claim 1.

Claim 1 include the limitation of “a scoop portion having ... a plurality of concave scallops ...

each scallop defining a segment of a single circle; and wherein the segments intersect at distinct forward points in a straight line generally perpendicular to the handle.” The Examiner concedes that Hicks “does not define circular segments that intersect at distinct points...” (Final OA, top of p. 5) Hicks is depicted below:



The Examiner’s argument is that “it would have been obvious ... to replace the serrated edge of Hicks with a circular segmented cutting edge ... to better penetrate through ice or snow due to the pointed tips located between adjacent circular segments.” (OA, middle of p. 5). The problem with this argument is that the Examiner *doesn’t actually know* that the proposed modification would, in fact, result in better performance. Not all implements need to be “pointed” to penetrate the material(s) they are intended to convey. Hoes, coal shovels and ice cream scoops purposely not “pointed.”

In fact, the strip or “shoe” of the Hicks article is rather complex, including trapezoidally shaped serrations “so as to form a series of cutting-edges or plows, which will readily enter and break up compact snow and ice (Hicks, lines 42-45). Thus, the forward edge of the Hicks implement performs at least two functions, namely, “entering and breaking up” at least two different materials, namely “compact snow and ice.” Since Hicks discloses but a single serrated pattern, one of skill in the art would presume that this is the pattern—and the only pattern—that Hicks prefers. One would assume

that the single pattern disclosed by Hicks performs the jobs of entering and breaking up compact snow and ice better than alternative designs, and that the chosen pattern was arrived upon through experimentation as opposed to speculation. In short, if the inventor was open to different patterns he would have at least made mention of them in the specification but he did not. The only conclusion is that Examiner's proposed substitution would render Hicks' article less effective for its intended purpose. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). If a proposed combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

The other problem with the Examiner's argument is that the Hicks implement *has no "scoop"* (*See drawings above*). As such, even if the proposed substitution of circular serrations for angular serrations were made, Appellants invention would not result. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; there must be a reasonable expectation of success; and the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143.

While Appellant concedes that the claim in question only includes the words "scoop portion," it would be a dramatic departure from the definition of the word "scoop" to include *the flat board* of Hicks. Simply stated, a flat board is not a scoop. The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). The written description must be examined in every case, because it is relevant not only to aid in the claim construction analysis, but also to determine if the presumption of ordinary and customary meaning is rebutted. *See Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998). The presumption will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth a definition of the term different from its ordinary and customary meaning. *See In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); *Intellicall, Inc. v. Phonometrics, Inc.*, 952

F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992). The presumption also will be rebutted if the inventor has disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope. *See Teleflex, Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313, 1324, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002).

In this instance, Applicant did not depart from the true meaning of the word “scoop,” which means “a large ladle,” “a deep shovel or similar implement,” “a usually hemispherical utensil for dipping food,” or “a small spoon-shaped utensil or instrument for cutting or gouging.” See <http://www.m-w.com/dictionary/scoops>. Again, although Appellant is well aware that limitations from the specification will not be read into the claims, they need not be. The claim sets forth a “scoop portion,” which *cannot mean a flat board*.

C. The rejection of claims 2-5.

Claims 2-5 all stand rejected under 35 USC §103(a) over Hicks, U.S. Patent No. 342, 961, in view of either U.S. Design Patent No. D308,004 to Dawley et al. or U.S. Patent No. 2,787,058 to Vogel on the grounds that “it would have been obvious to ... to dimension the resulting circular segments to various sizes and quantity depending on the desired task at hand.” (OA, middle of p. 5) This omnibus-type rejection fails to address structural claim limitations deserving of examination.

Claims 2-5 all set forth positive structural limitations involving specific blade geometries. Claim 2 states that the width of the scoop portion ranges between 6 and 24 inches, and the number of scallops ranges between 3 and 12. Claim 3 states the points are spaced apart by a distance ‘d’, and the radius of each scallop, ‘r,’ is greater than d/2. Claim 4 states that the points are spaced apart by a distance ‘d’, and the radius of each scallop, ‘r,’ is substantially equal to ‘d’. Claim 5 sets forth that the points are spaced apart by a distance ‘d’, and the radius of each scallop, ‘r,’ is greater than ‘d’.

The Examiner rejects these limitations on omnibus grounds; that is, that it would be obvious “to design the tool dimensions based on the application of the tool.” This is nothing more than an impermissible “obvious to try” rationale, precluding *prima facie* obviousness.

- D. The rejection of claim 8 under U.S.C. §103(a) over Hicks/ Dawley et al. or Hicks/ Vogel and further in view of Johnson, U.S. Patent No. 2,782,615.

Claim 8 includes the limitation of “stiffening ribs.” The Examiner argues that it would be obvious to add stiffening ribs to Hicks as taught by Johnson “to strengthen the resulting blade and handle heavier loads.” Let us not forget that the “blade” of Hicks is a flat wooden board. Indeed, the invention of Hick is not the blade or handle, but rather a strip that attached to the piece of wood. In other words, Hicks’ use of a piece of wood is a given that Hick s must contend with and is not a part of Hicks’ invention. Additionally, not only is there no factual evidence from the prior art to make this modification, there is no way to know how it would be carried out. Would the “ribs” also be made of wood? Would they be nailed on? Or screwed on? Does the flat board of Hicks need to “handle heavier loads”? Since questions such as these cannot be answered, *prima facie* obviousness has not been established.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board’s concurrence at this time.

Respectfully submitted,

By: _____

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Date: Dec. 4, 2007

APPENDIX A

CLAIMS ON APPEAL

1. An improved blade for a shovel having an elongated handle, the blade comprising:
a scoop portion having a width, a length, and a leading edge furthest away from the handle;
a plurality of concave scallops on the leading edge, each scallop defining a segment of a single circle; and

wherein the segments intersect at distinct forward points in a straight line generally perpendicular to the handle.

2. The improved shovel of claim 1, wherein:
the width of the scoop portion ranges between 6 and 24 inches; and
the number of scallops ranges between 3 and 12.

3. The improved shovel of claim 1, wherein:
the points are spaced apart by a distance 'd'; and
the radius of each scallop, 'r,' is greater than $d/2$.

4. The improved shovel of claim 1, wherein:
the points are spaced apart by a distance 'd'; and
the radius of each scallop, 'r,' is substantially equal to 'd'.

5. The improved shovel of claim 1, wherein:
the spaced are apart by a distance 'd'; and
the radius of each scallop, 'r,' is greater than 'd'.

6. The improved shovel of claim 1, wherein the scallops are substantially identical.

7. The improved shovel of claim 1, wherein the scoop portion is configured for snow shoveling.
8. The improved shovel of claim 1, wherein the scoop portion includes stiffening ribs.
9. The improved shovel of claim 1, wherein the scoop portion is configured for gardening.
10. The improved shovel of claim 1, wherein the scoop portion is configured for ice scraping.
11. The improved shovel of claim 1, wherein the leading edge is attached to the scoop portion.
12. The improved shovel of claim 1, wherein the leading edge and scoop portion are constructed from dissimilar materials.

APPENDIX B

EVIDENCE

None.

APPENDIX C
RELATED PROCEEDINGS

None.